

### **Remarks/Arguments**

The foregoing amendments to the claims are of formal nature, and do not add new matter. These amendments are done in response to the telephone conference with Examiner Blanchard on July 25, 2005, merely to expedite the prosecution of this case.

Claims 124 and 143 have been amended to remove references to the term “extracellular domain”. Claim 127 has been canceled without prejudice or disclaimer. Accordingly, Claims 124-126, 129-131, 135-138 and 143 are currently pending in this application.

### **Claim Rejections – 35 USC § 102**

22. Claims 124-126, 129-131, 135-138 and 143 are rejected under 35 U.S.C. §102(a) as being anticipated by Jacobs (WO 98/32853, dated July 30, 1998).

The Examiner had acknowledged in the telephone conference of July 25, 2005 that the Applicants were entitled to an effective priority date of May 29, 1998 for the instantly claimed sequence provided the declaration executed by Dr. Austin Gurney, one of the inventors in this case, were filed under 37 C.F.R. §1.131.

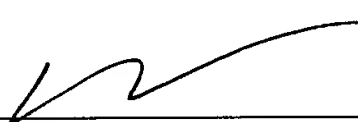
Applicants hereby submit the executed declaration by Dr. Austin Gurney under 37 C.F.R. §1.131. Applicants believe that this submission should be sufficient to obviate the instant rejection anticipated by Jacobs, since Applicants had cloned and sequenced the nucleic acid on **May 29, 1998**, thereby predating the Jacobs reference. Accordingly, the pending claims are not anticipated by Jacobs *et al.* and this rejection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-2730P1C67). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

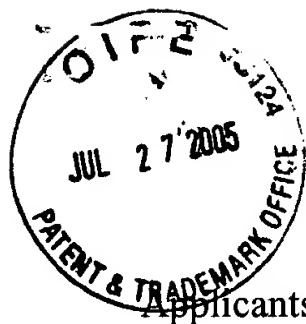
Date: July 27, 2005

  
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7/27/05 11:41 AM (39780.2730)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Ashkenazi et al. Docket No: 39780-2730P1C39 and  
39780-2730P1C67  
Serial No: 09/997641 & 09/989724 Group Art Unit: 1647  
Filed: Examiner: David Blanchard  
For: **SECRETED AND TRANSMEMBRANE POLYPEPTIDES AND NUCLEIC  
ACIDS ENCODING THE SAME**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**DECLARATION OF LUC DESNOYERS, Ph.D.,**  
**AUDREY GODDARD, Ph.D., PAUL J. GODOWSKI, Ph.D.,**  
**AUSTIN GURNEY, Ph.D., NICHOLAS PAONI, Ph.D., and WILLIAM I. WOOD, Ph.D.**  
**UNDER 37 C.F.R. §1.131**

We, Luc Desnoyers, Ph.D., Audrey Goddard, Ph.D., Paul J. Godowski, Ph.D., Austin Gurney, Ph.D., Nicholas Paoni, Ph.D. and William I. Wood, Ph.D. declare and say as follows:

1. We are the inventors of the above-identified application.
2. We have read and understood the claims pending in this application, and are aware that the claims have been rejected as anticipated by PCT Patent Publication WO 98/32853 (Jacobs *et al.*, dated July 30, 1998).
3. The polypeptide designated as PRO1312 (SEQ ID NO:387) claimed in the above-identified application in the United States was sequenced and cloned prior to July 30, 1998.
4. At the time the PRO1312 polypeptide was cloned and sequenced, one of the inventors, Austin Gurney, Ph.D., was responsible for overseeing the cloning of cDNAs which encoded novel polypeptides, including the cDNA that encoded PRO1312 polypeptide (SEQ ID NO:387) claimed in the above-identified application.

5. At the time the PRO1312 polypeptide was cloned and sequenced, one of the inventors, Audrey Goddard, Ph.D., was responsible for overseeing the sequencing of cDNAs encoding for novel polypeptides, including the PRO1312 polypeptide (SEQ ID NO:387) claimed in the above-identified application.
6. A cDNA clone, referred to as DNA61873-1574 in the above-identified application, was identified as encoding the PRO1312 polypeptide.
7. The full length of the cDNA clone is shown in Figure 277 of the above-identified application. The full length of the PRO1312 peptide encoded by DNA61873-1574 is shown in Figure 278 of the above-identified application. The full-length PRO1312 polypeptide has 212 amino acid residues.
8. Copies of the pages from the GSeqEdit database which report the cloning and sequencing data for the PRO1312 polypeptide sequence and its encoding nucleic acid sequence are attached to this declaration (with the dates redacted) as Exhibit A.
9. The GSeqEdit report shows the full-length nucleic acid sequence for DNA61873-1574 (identified as "DNA-61873") and the full-length PRO1312 polypeptide encoded by DNA-61873. Both the DNA-61873 and the PRO1312 polypeptide sequences were obtained prior to July 30, 1998.
10. The DNA-61873 sequence shown in the GSeqEdit report is identical to that of SEQ ID NO: 386 disclosed in the above-identified application.
11. The beginning of the cDNA sequence corresponding to SEQ ID NO: 386 in the above-identified application is shown on page 1 of the GSeqEdit database report, and the location of the first nucleotide is marked with "insert starts here" and an arrow. The location of the last nucleotide corresponding to SEQ ID NO: 386 is shown on page 7 and is marked with an arrow.
12. The amino acid sequence shown in the GSeqEdit report is identical to that of SEQ ID NO: 387 disclosed in the above-identified application.

13. The first 4 amino acid residues of the PRO1312 polypeptide (SEQ ID NO:387) encoded by the cDNA (DNA-61873) are also shown on page 1 of the GSeqEdit report and the remaining 208 residues appear on pages 2-4 of the report.
14. All activities listed under paragraphs 4-13 were completed prior to July 30, 1998. (See Exhibit A).
15. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information or belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

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Luc Desnoyers, Ph.D.

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Date

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Audrey Goddard, Ph.D.

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Date

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Paul J. Godowski, Ph.D.

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Date

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Nicholas Paoni, Ph.D.

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Date

  
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Austin Gurney, Ph.D.

  
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Date

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William I. Wood, Ph.D.

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Date